

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

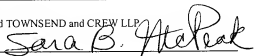
021737-000110US

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on November 16, 2006

TOWNSEND and TOWNSEND and CREW LLP

Signature

Typed or printed name Sara B. McPeak

Application Number

09/872,764

Filed

June 1, 2001

First Named Inventor

Jeffrey J. Grainger et al.

Art Unit

3621

Examiner

Mary Da Zhi Wang
Cheung

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 44,187☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____



Signature

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Typed or printed name

303.571.4000

Telephone number

November 16, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☐

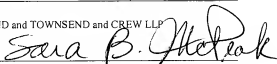
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on November 16, 2006

STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW

TOWNSEND and TOWNSEND and CREW LLP

By:



Sara B. McPeak

PATENT
Attorney Docket No.: 021737-000110US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jeffrey J. Grainger et al.

Application No.: 09/872,764

Filed: June 1, 2001

For: COMPUTER-IMPLEMENTED
METHOD FOR SECURING
INTELLECTUAL PROPERTY

Customer No.: 20350

Confirmation No.: 2173

Examiner: Mary Da Zhi Wang Cheung

Art Unit: 3621

STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of the Pre-Appeal Brief Request for Review, that is submitted herewith, along with a Notice of Appeal. The applicant respectfully requests review of the final office action mailed August 16, 2006, that rejected claims 1-3 and 38-39 under 35 U.S.C. § 102(a) as being anticipated by ePAVE User Guide, published by U.S. Patent and Trademark Office on January 12, 2000 ("ePAVE"). The final office action also rejected claims 4-17 under 35 U.S.C. § 103(a) as being unpatentable over ePAVE, taken either alone or in combination with other references. It is believed that these rejections are unfounded, and review of the rejections is respectfully requested.

Claim 1, 38 and 39 are independent claims, and claims 38 and 39 are directed to a software program and system, respectively, that correspond to claim 1. It is respectfully

submitted that the ePAVE reference fails to teach or suggest each limitations of any of these claims, and reconsideration of their rejections is respectfully requested. As noted in the applicants' response dated May 30, 2006, the ePAVE tool is a patent application submission tool developed by the PTO for electronic submission of patent applications. It is not a tool that can be used to create a patent application.

As such, neither the tool itself nor the ePAVE reference, that describes the tool, contains any disclosure of, for example, an "electronic invention disclosure form to be filled out," as recited by claims 1, 38 and 39. The final office action takes the position that "ePave teaches an electronic invention disclosure forms to be filled out, such as patentee information, and attorney or agent information." Even assuming ePAVE provides this functionality, the mere ability to provide biographical information about a patentee and/or attorney does not teach or suggest that ePAVE provides any facility for an inventor to disclose an invention, that is the purpose of an invention disclosure statement. Indeed, the ePAVE reference clearly indicates that the patentee is required to provide a pre-existing patent application, which the ePAVE tool then converts into a format acceptable to a patent office.

Further, the ePAVE reference fails to teach or suggest "receiving a filled-out invention disclosure in electronic form on the first server." Even assuming the ePAVE client software might be considered as providing an invention disclosure form (which it cannot), the ePAVE software necessarily provides a completed application to the USPTO server, not a filled-out invention disclosure in electronic form. Hence, to the extent the ePAVE system ever receives a filled-out disclosure form (which it does not), it is the client that receives this information, not the server. Indeed, the entire point of the ePAVE client software is to produce a patent application (or, more properly to convert an existing patent application) in a form suitable for filing electronically. Hence, even under the most generous interpretation, the ePAVE fails to disclose the claimed element, that requires receiving a filled-out invention disclosure in electronic form on the first server.

This deficiency in the ePAVE system is highlighted by the fact that ePAVE simply cannot satisfy the element of "automatically converting the invention disclosure form into

a format of a patent application in response to a single click instruction by the user," as recited by the independent claims. It cannot be disputed, and is in fact conceded by the final office action, that "ePAVE teaches electronically submitting a filled-out patent application by a user, and the USPTO's computer will then send acknowledgement receipt." Assuming this is true, and the USPTO server receives "a filled-out patent application," it would be impossible for the server to automatically convert an invention disclosure form of a patent application, since that operation is performed before the application ever reaches the server (since the server receives a "filled-out" —i.e., already-converted—application, not an invention disclosure form).

The final office action attempts to finesse this deficiency by arguing that "ePave further teaches by click on 'Send to USPTO' button, the user's input regarding to the patent application will then be filed as an electronic patent application in USPTO." However, the Office cannot have it both ways: if the application is already in complete form before it is filed at the server (as the final office action argues, as noted above), then the server necessarily cannot be understood to convert an invention disclosure form to an application.

Moreover, nothing in the ePAVE reference provides any indication that the ePAVE system on the USPTO server adds any of the biographical information provided by the user to the application after the application arrives at the server. Instead, all indications are that the biographical information is used only for the USPTO's convenience, and that (as noted above), the application is complete before it is ever filed with the USPTO.

Hence, the final office action fails to establish that the ePAVE reference teaches or suggests virtually any of the elements of claim 1. The other cited references fail to provide any of the disclosure missing from the ePAVE reference. Accordingly, reconsideration of the rejection of claim 1 therefore is respectfully requested. For at least similar reasons, the rejections of claims 38 and 39 are believed to be deficient. Claims 2-17 each depend from claim 1 and are believed to be allowable at least by virtue of their dependence from claim 1.

Application No. 09/872,764

PATENT

Statement of Reasons in Support of Pre-Appeal Brief Request for Review

Date: November 16, 2006

Accordingly, all of the claims now pending are believed to be allowable over the cited references, and reconsideration of the final rejections is respectfully requested.

Respectfully submitted,

Date: November 16, 2006

/Chad E. King/

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